

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 05-1128-A1)

In the Application of:)
Richard Martin) Examiner: Brenda Libby Coleman
Application No.: 10/565,702) Art Unit: 1624
Filing Date: September 13, 2006) Confirmation No.: 2568
For: Azepine Derivatives as Pharmaceutical)
Agents)

PETITION UNDER 37 CFR 1.181 TO WITHDRAW FINALITY OF REJECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The applicants petition to withdraw the finality of the Office Action mailed September 30, 2010, because it was improper.

The applicants submit that the examination procedure employed was improper, being inconsistent with the legal requirements for search and examination of Markush claims embodied in MPEP § 803.02.

The applicants first present a summary of the relevant prosecution history followed by their arguments.

File History Summary

In a restriction requirement mailed August 7, 2009, the Office imposed an election of one of five inventions, and further set forth a requirement to elect a single species within the elected group. The applicants replied on February 5, 2010 with an election of group and species without traverse.

In the first office action on the merits mailed April 14, 2010, the Office acknowledged the election, and withdrew claims 6-31 from further consideration as being drawn to a nonelected invention. All rejections of the claims fell under 35 USC § 112, either as failing to

CERTIFICATE OF TRANSMISSION (37 C.F.R. 1.8)

I hereby certify that this correspondence is being transmitted to the USPTO via the USPTO EFS on December 10, 2010.

Date: December 10, 2010

/Michael S. Greenfield/
Michael S. Greenfield

comply with the enablement requirement or as being indefinite; significantly, no prior art rejections were made.

In their response filed July 14, 2010, the applicants argued that pursuant to MPEP § 803.02 the Office's withdrawal of claims 6-31 was premature because no rejections under 35 USC § 102 or §103 had been made. The applicants also amended the claims and argued against the enablement and indefiniteness rejections.

In a final office action mailed September 30, 2010, the Office maintained the withdrawal of claims 6-31 and argued that the applicants' traversal of the Office's withdrawal of claims 6-31 was moot because the applicants had originally elected the invention and species without traverse. The Office withdrew some of the 35 USC § 112 rejections, maintained others, and provided new grounds of rejection under 35 USC § 112. As before, no prior art rejections were made.

In a response to the final action filed November 24, 2010, the applicants clarified that they had not argued that the restriction requirement itself was improper, but rather that under MPEP § 803.02 the Office's withdrawal of claims 6-31 in response to applicants' election was improper. Applicants further amended the claims and provided arguments against the pending 35 USC § 112 rejections.

In an Advisory Action mailed December 2, 2010, the Office noted that the application had only been searched to the extent of the elected species and further asserted that the restriction mailed August 8, 2009, "was a restriction between groups I-IV [sic] and not an election of species."

Argument

The applicants respectfully submit that the search and examination procedure employed by the Office is inconsistent with Patent Office guidelines and has deprived the applicants of their right to a full search of the claims. Therefore, the final rejection should be withdrawn and the claims searched to the full extent permitted by the prior art, up to the full scope of the claims.

In the present application, examination has been conducted only on the elected species, as stated by the Office in the December 2010 Advisory Action; all claims drawn to unelected species (claims 6-31) were withdrawn by the Office even though no prior art rejections were made. The applicants respectfully submit this is in violation of the PTO requirement of compact

examination (e.g., MPEP § 707.07(g) and MPEP § 2106(II) (“Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement.”)), and MPEP § 803.02.

The proper procedure for examining Markush claims is set forth in MPEP § 803.02:

A Markush-type claim may include independent and distinct inventions. ... In applications containing a Markush-type claim that encompasses at least two independent or distinct inventions, the examiner may require a provisional election of a single species prior to examination on the merits. ... Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable, the provisional election will be given effect and examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.

As an example, in the case of an application with a Markush-type claim drawn to the compound X-R, wherein R is a radical selected from the group consisting of A, B, C, D, and E, the examiner may require a provisional election of a single species, XA, XB, XC, XD, or XE. The Markush-type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected, and claims to the nonelected species would be held withdrawn from further consideration.

On the other hand, should the examiner determine that the elected species is allowable, the examination of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The examination will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action can be made final unless the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

(Emphasis added.) The applicants submit that according to MPEP § 803.02, a search of a Markush claim (*which may include independent and distinct inventions*) is to begin with the elected species and if the species is allowable over the prior art expanded to the full scope of the claims allowable over the prior art. The search may be stopped short of the full scope only if prior art is found that renders the claims unpatentable as anticipated or obvious; rejections under 35 USC § 112 are not a proper basis for limiting the search to the elected species. This is consistent with the policy of compact prosecution, which requires simultaneous examination of the claims as to all bases of patentability.

Because an improper search and examination procedure was employed and the applicants were denied the search to which they were entitled, the applicants respectfully submit that the Office should withdraw the final rejection and search the claims (including claims 6-31) to the full extent permitted by the prior art, up to the full scope of the claims. Should prior art be identified, a non-final action would be appropriate to permit the applicants an opportunity to amend the claims and/or argue in favor of patentability. If the prior art rejection is thereby overcome, the search should be expanded once again, as is consistent with the example provided in MPEP § 803.02.

The applicants also request that any prosecution delays otherwise attributable to the applicant resulting from the improper imposition of the final Office Action be attributed to the Patent Office and that all extension of time fees necessitated by the improper imposition of the final Office Action be refunded to deposit account no. 13-2490.

If there are any questions or comments regarding this application, the Examiner is encouraged to contact the undersigned in order to expedite prosecution.

Respectfully submitted,

Date: December 10, 2010

/Michael S. Greenfield/
Michael S. Greenfield
Registration No. 37,142

Telephone: 312-913-0001
Facsimile: 312-913-0002

McDonnell Boehnen Hulbert & Berghoff LLP
300 South Wacker Drive
Chicago, IL 60606